

REMARKS

The Final Rejection mailed August 23, 2006, and the prior art applied therein, including the newly cited prior art, have been carefully studied. Upon entry of the present amendment, the claims in the application will be only claim 1 as amended to incorporate claim 3, and those claims previously dependent on claim 3, namely claims 7, 8 and 10-12. Applicant again respectfully asserts that these claims define patentable subject matter under all provisions of the statute including §§102 and 103, and therefore should be allowed. Favorable reconsideration, entry of the amendment presented above, and allowance are earnestly solicited.

Non-elected and withdrawn claim 6 has now been cancelled without prejudice to applicant's rights to pursue this claim and similar subject matter in a divisional application with full reliance on applicant's rights, including those provided by §§121, 120 and 119.

As regards entry of the present amendment, no new issues are raised, so this amendment should be entered at least for purposes of appeal if the rejection is maintained contrary to applicant's position. The amendment to claim 1 raises no new issue in that claim 3, previously examined, has

been incorporated bodily into claim 1. All those claims which depended directly from claim 1 (not from claim 3) are proposed to be deleted above, so no new issues are raised in this regard as well.

For the record, all of the amendments presented above are made without prejudice to applicant's rights, including those rights provided by §§119 and 120, to pursue broader claims in a continuing application if applicant chooses to do so, without any penalty whatsoever.

Claims 1-4 and 7-12 have been rejected under §103 as obvious from Braun (previously applied) in view of Uda (previously applied) and further in view of newly cited and applied Kwak USP 5,510,587 (Kwak). This rejection is respectfully traversed.

The proposed combination of Braun in view of Uda is deficient for the reasons pointed out in the last response, respectfully repeated by reference. Briefly, even if the proposed combination of Braun and Uda were obvious, e.g. the use of Braun's material in Uda's molding method, the combination would not reach the subject matter of claim 1 even without the added features of claim 3, and would not yield applicant's product with its advantages. The geometry and coplanar relationship of the separator molding portions of the cavity are important in achieving the advantages of the

present invention, and these features are not disclosed or made obvious in either Braun or Uda.

In answer to the aforementioned remarks of applicant, the PTO has now further relied on newly cited Kwak. The rejection states in this regard:

Kwak shows that it is known to carry out a method of molding using a plurality of plate-like separator molding portions that are disposed in a co-planar relationship to one another, wherein adjacent separator molding portions of said plurality of plate-like separator molding portions define therebetween connection portion ribs which during molding produce thin walled excess portions between adjacent molded co-planar fuel cell separators (Figure 1). Kwak and Braun are combinable because they are concerned with a similar technical field, namely, methods of injection molding conductive articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Kwak's mold configuration during Braun's molding method in order to produce the desired article in the desired quantity.

However, applicant respectfully maintains that it would not have been obvious to combine Kwak with the aforementioned Braun/Uda combination for the reasons pointed out below.

First, the rejection is incorrect when it states that Kwak and Braun are combinable because they are both concerned with injection molding. Kwak does not involve injection molding. The type of molding employed in Kwak

involves the transfer of a plug of resin (16) utilizing a transfer-rod (18). The entire idea in Kwak is to provide a machine which is capable of transferring the plug of solid resin in either an upward direction or a downward direction, noting for example the stated object near the top of column 2 as follows:

It is... an object of this invention to provide a molding machine... that may selectively move the transfer-rods as needed so as to use either mold into which a flanger tip supplies resin when moving from downward as in the conventional mold or a mold into which a flanger tip supplies resin when moving upwardly.

Kwak has no relationship with the present invention and no relationship with either Braun or Uda. The combination would not have been obvious to a person of ordinary skill in the art at the time the present invention was made because no reason or purpose, motive or incentive exists for even attempting to combine the references, the only "teaching" coming from applicant's own disclosure which was not available to the person of ordinary skill in the art at the time the present invention was made.

Moreover, even if the rejection were correct (which it is not) in stating that the references are combinable because they are both concerned with methods of injection molding, the law makes clear that simply because two

references come from the same art is no basis for their combination. In this regard, attention is respectfully invited to *In re Levitt*, 11 USPQ 2d 1315, 1316:

The mere fact that both references originate from the [same] art does not provide any teaching or suggestion to combine them.

There is nothing in any of the references which would have led the person of ordinary skill in the art to attempt to combine the references in any way, let alone in such a way as to select one or two minor incidental features from Kwak to substitute for features in Braun/Uda.

The rejection is also incorrect in stating that Kwak shows ribs between adjacent plate-like separator molding portions which during molding produce thin walled excess portions between the adjacent co-planar molded elements. As can be clearly seen from Fig. 2 of Kwak, only two mold cavities are provided, and there are no ribs or indeed anything comparable to the connecting portions 9 that connect the plurality of separator molding portions according to applicant's illustrated embodiments.

Accordingly, even if the proposed combination were obvious, strongly traversed by applicant for the reasons pointed out above, the resultant reconstruction provided by such combination would not reach claim 1.

Withdrawal of the rejection is in order and is respectfully requested.

As regards previous claim 3, now incorporated into claim 1, the combination of Braun and Uda, even if obvious, would not reach what was recited in the dependent portion of claim 3, now incorporated into claim 1. Figs. 1-4 of Uda clearly show not only a sprue and gate portion, but also runners (element 2 in Figs. 1 and 2; see column 6, line 37). Uda absolutely does not supply resin directly through a gate only or through a sprue portion and the gate portion only, and the rejection is simply factually incorrect in this regard.

Regarding claim 7, again the rejection has not at all addressed the parts of claim 7 which are recited in the dependent portion thereof. The law is clear that all recitations which appear in an applicant's claims are to be given effect, and not to be ignored or brushed aside. No possible combination of the references could meet even only the dependent portion of claim 7, let alone the entirety of claim 7 including claim 1 upon which claim 7 depends and incorporates.

Accordingly, at least claim 7 defines patentable subject matter not only because it depends from and incorporates the subject matter of claim 1 (now including also

claim 3), but also because the dependent portion of claim 7 defines non-obvious subject matter.

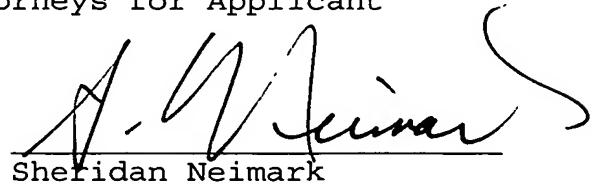
Claim 13 has been rejected as obvious from Braun in view of Uda and Kwak and further in view of newly cited Adell USP 4,239,724. Applicant need not address this rejection at the present time in view of the proposed deletion of claim 13 above. However, as also indicated above, applicant reserves the right to pursue other claims and also broader claims in a continuing application, if applicant chooses to do so.

Applicant submits and believes that all issues raised in the Final Action have been addressed above in a manner which should lead to allowance of the present application. Applicant therefore respectfully requests favorable reconsideration, entry of the amendments presented above, and early formal allowance.

Respectfully submitted,

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